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Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80528-9599

EXAMINER

LANEAU, RONALD

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3714

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/785,969
Filing Date: February 17, 2001
Appellant(s): MEYER ET AL.

MAILED
JAN 22 2006
GROUP 3700

Steven R. Ormiston
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 10/31/06 appealing from the Office action
mailed 05/24/06

Art Unit: 3714

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,836,617	PARUSKI	12-2004
6,715,003	SAFAI	03-2004
6,456,391	MIYAMOTO	09-2002

Art Unit: 3714

Eastman Kodak: Kodak to acquire 51% stake in Picture Vision, M2 Presswire, February 13, 1998, pg. 1.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-3, 7-10, 13-16, 18, 24-27, 33, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski (US 6,836,617 B1) in view of Safai (US 6,715,003) and further in view of Miyamoto (US 6,456,391 B1).

Parulski teaches a method of receiving a least one digital image from memory of an imaging device (col. 13, lines 43-45), performing a point-of sale transaction for storing a least one digital image at a remote site (see abs., lines 8-10; the uploading is done to a remote site from the electronic database). Uploading can be done via the Internet and the remote storage site would include an image storage web site (col. 8, line 67 to col. 9, line 4, fig. 2). Parulski further teaches that removing memory accesses the digital image from the imaging device and inserting the memory into a memory reader (Fig. 29 (0012)).

Safai discloses displaying a price for storing the at least one digital image at the remote site; prompting a customer for payment of the price; receiving a payment for storing the at least

Art Unit: 3714

one digital image at the remote site; storing the at least one digital image at the remote site (col. 25, lines 45-50 and col. 27, lines 30-43).

Neither Parulski nor Safai teaches printing the sales receipt including a thumbnail of the digital image to confirm storage but Miyamoto discloses printing a sales receipt for the transaction including a thumbnail of the at least one digital image to confirm storage of the at least one digital image as claimed (col. 3, lines 20-26). The index print in this case would be equaled to the sale receipt Applicant claims because it is the confirmation of all images stored. The printing of the thumbnail on a printing paper is evidence that it can also be used on a sales receipt that would include the price paid for storing the image at the remote site and the date the payment was received as claimed.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the well-known step of receiving and accessing at least one digital image by reading memory that had been removed from the digital imaging device as already taught in Safai for the purpose of being able to have the ability to access all types of digital cameras and thus be able to service all customers at the kiosk thereby maximizing revenues and profits.

It would have been obvious to one of ordinary skill in the art to utilize the printing of a sales receipt including a thumbnail view to confirm storage of the digital image or documents as taught by Miyamoto into the combined teachings of Parulski and Safai because it would maximize the efficiency of storing and indexing electronic documents.

Claims 19-21 are rejected for the same reasons set forth in the method claim above.

As per claims 8 and 9, Safai discloses that the remote site is a server/image storage web site (col. 25, lines 45-50); storing digital images takes up space and that the uploading of the

Art Unit: 3714

stored information directly to a personal computer required the availability of such a computer when using the capture device can be cumbersome or inconvenient; convention digital capture devices typically include a limited internal memory unit for storage of digital photos or videos and that the compact nature of the device also generally limits the space allocated for internal memory so that once the stored data fills allocated space the digital information must be uploaded and erased or the entire memory unit must be replaced in order to store additional data (see fig. 7).

Furthermore, image storage web sites are connected to a remote server were well-known in the art for just these purposes, i.e. Shutteriy.com, Fujifilm.net, clubphoto.com, photoaccess.com and Applicant's own site cartoga.com, among many others.

It would have been obvious to one having ordinary skill in the art at the time of the invention to have utilized a remote site of an image storage web site, which would have incorporated a server as already taught in Safai because the skilled artisan would have recognized that this business practice accrues the advantages explicitly taught by Safai.

As per claims 30-32, the combined systems of Parulski, Safai and Miyamoto do not expressly teach a method wherein uploading the at least one digital image to the remote site further comprises mailing the recordable medium to the remote site, wherein the recordable medium is a CD-ROM and wherein the recordable medium is a tape but it is obvious that having a CD ROM and a tape as a recording medium is well known in the art and one would be able to mail it to a remote site after storing it in a CD ROM or a tape as claimed.

Parulski does not teach printing the sales receipt including a thumbnail of the digital image to confirm storage but Miyamoto discloses printing a sales receipt for the transaction

Art Unit: 3714

including a thumbnail of the at least one digital image to confirm storage of the at least one digital image as claimed (col. 3, lines 20-26). The index print in this case would be equaled to the sale receipt Applicant claims because it is the confirmation of all images stored. It would have been obvious to one of ordinary skill in the art to utilize the printing of a sales receipt including a thumbnail view for the same reasons given above.

As per claims 15 and 16, the following means are equivalent to the descriptions set forth in the reference.

Means for receiving digital images from imaging device memory (equivalent to a digital camera where the image data is received by reading by reading memory that has been removed from the camera);

Means for performing point-of-sale transactions for storing at least some of the images at a remote site (equivalent to the uploading done to a remote site the image server as it is not stored in your camera or PC it is remote).

Means for electronically transmitting paid-for images to the remote web site (equivalent to the uploading is done to a remote site from the electronic database; See abs., transfer includes docking station, modem, transceiver, cable telephone line – all electronic forms).

Parulski teaches an article for a machine having a processor (CPU for the server) and an interface (the software on the website that enables a program to work with the user/input device (the user interface, which can be, a command-line interface, menu-driven, or a graphical user interface), with another program such as the operating system or the computer's hardware), the article comprising:

Computer memory (server); and

Art Unit: 3714

A program encoded in the computer memory, the program, when executed, instructing the processor to receive digital images via the interface, determine a price for storing the digital images at a remote site, process payment information, and send paid-for digital images to the remote site (how the web site operates as set forth in the method, it could not operate without a computer program encoded into the computer memory). Thus, the article for manufacture is rejected for the reasons set forth in the method claims and the explanation set forth above.

Parulski teaches a digital image display device 500 that produces color LCD, from image provided on a removable memory card 530 or via a host interface 542 from a host computer 540 (col. 13, lines 46-50).

Neither Parulski nor Safai discloses printing the sales receipt including a thumbnail of the digital image to confirm storage but Miyamoto discloses printing a sales receipt for the transaction including a thumbnail of the at least one digital image to confirm storage of the at least one digital image as claimed (col. 3, lines 20-26). It would have been obvious to one of ordinary skill in the art to utilize the printing of a sales receipt including a thumbnail view for the same reasons given above.

11. Claims 4, 17, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski (US 6,836,617 B1) in view of Safai (US 6,715,003) and further in view of www.telepix.com

Neither Parulski nor Safai teach printing a sales receipt for the transaction identifying information about the digital images that were paid for. www.telepix.com teaches receiving at least one digital image from memory of an imaging device, storing at least one digital image at a

Art Unit: 3714

remote site (image storage web site) and allowing it to be accessed, uploading digital images to the remote site via the internet from a wide variety of digital camera memory cards, printing a sales receipt for transactions that occur at the kiosk (Photostation 2000 - automatic job order logging and receipt printing). www.telepix.com further teaches that the kiosk is a mini-kiosk (has a memory card reader - external compact flash, smart media, PCMCIA card reader), a processor responsive to the card reader and programmed to perform a point-of sale transaction and sends digital images to a remote storage site (400 MHz AMD K6 processor - automatic job order logging and receipt printing; internet connectivity to Telepix Photo Network - display, share, download, email and print), a data communication device responsive to the processor for sending the digital images to the remote site (Integrated 10/100 Ethernet network port, Dual Universal Serial Bus, Supports dial-up, ISDN, ADSL or cable modem connectivity), at least one device, coupled to the processor, for entering payment information (wireless infrared keyboard for enhanced security in setup and administration, easy to use touch screen user interface), a receipt printer coupled to the processor, whereby the processor can command the printer to print out receipts of the transactions (receipt printing).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have included the step of providing a printed sales receipt through a printer in the mini-kiosk as taught in www.telepix.com in the combined system of Parulski and Safai as this business practice provides the customer with necessary information, saves time spent by a customer in making purchases, enhances customer satisfaction and entices customers to stay with the business. Moreover, it would have been obvious to one having ordinary skill in the art at the

Art Unit: 3714

time of the invention to have added identifying information about the digital images that were paid for to the receipt for the reasons set forth above.

12. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski (US 6,836,617 B1) in view of Safai (US 6,715,003) further in view of Miyamoto (US 6,456,391 B1) as applied to claims 1 and 11 above, and further further in view of Eastman Kodak: Kodak to acquire 51% state in Picture Vision, M2 Presswire, February 13, 1998, pg. 1.

Parulski, Safai and Miyamoto teach as set forth above. However, neither Parulski nor Safai nor Miyamoto teach that the owner of the kiosk has a fee agreement with the owner of the storage site. M2 Presswire teaches that PictureVision built the leading franchise at retail, i.e. digital image storing. Franchising is a form of a fee agreement with an owner of a remote storage site. M2 Presswire further teaches that this form of transaction based processing gives customers more benefits by allowing them to share their photos quickly and easily through the combined service, i.e. retail kiosks and the owned remote storage. Moreover, it is well known in the business art that if one does not own space one pays for it, i.e. rents it, leases it, or buys it. The same is true of a service that one provides to a customer. It would have been obvious to one having ordinary skill in the art at the time of the invention to have included the step of having the owner of the kiosk have a fee agreement with the owner of the remote storage site in the combined system of Parulski, Safai and Miyamoto as taught in M2 Presswire because the skilled artisan would have recognized that this business practice is a mechanism by which the remote storage site stays profitable and stays in business, would follow in the internet world from the business community where competition is sometimes world wide and customers have a greater

Art Unit: 3714

influence on the success of a business and provides a valuable service to the kiosk owner by avoiding the need for him incur the costs of setting up his own web site for his customers, when he can pay a low fee for a site that is already set up and can be off-set in other negotiated ways through the franchised licensing agreement.

Response to Arguments

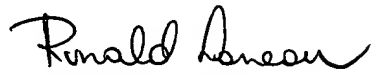
13. Applicant's arguments filed on 3/10/06 have been fully considered but they are not persuasive.

Applicant argues that Miyamoto's index print of thumbnail images is not a sales receipt. In response to Applicant's arguments, although Miyamoto does not explicitly disclose a sales receipt but one of ordinary skill in the art does not anticipate any problem for Miyamoto's system to print a thumbnail image on a sales receipt as claimed. Applicant further argues that neither Parulski nor Miyamoto discloses "sending digital images from a user's digital camera to a remote storage site but the newly added reference (Safai) is used to disclose such features. All other arguments are moot in view of Safai (see above rejection). As a result, claims 1-4, 7-27, 29-34 and 36 are finally rejected.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Art Unit: 3714



Ronald Laneau

Primary Examiner

Conferees:

Alexander Kalinowski 

Sam Sough 